REMARKS

Claims 1-15 were examined and reported in the Office Action. Claims 1-15 are rejected. Claims 1-3, 6-8, 10 and 12 are amended. Claims 1-15 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I.   **35 U.S.C. § 101**

It is asserted in the Office Action that claims 1-7 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended claim 1 to clarify the claimed invention and to specify that the claimed invention is directed to statutory subject matter.

Accordingly, withdrawal of the 35 U.S.C. § 112, second paragraph rejection for claims 4-5 is respectfully requested.

III.   **35 U.S.C. § 103(a)**

A.   It is asserted in the Office Action that claims 1-12 are rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 6,065,026 issued to Cornelia et al ("Cornelia"), further in view of "*Special Edition Using Microsoft Word 97*", 12/16/1996 by Person et al ("Person"), in further view of U.S. Pub. No. 2001/0014900 by Brauer et al. ("Brauer"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

> [t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at __, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, "[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*." And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, "[t]he mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). Additionally, according to MPEP §2143

> [a] statement that modification of the prior art to meet the claimed invention would have been "<u>well within the ordinary skill of the art</u> at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

It is asserted in the Office Action that Cornelia creates a grammar-neutral document object and cites Cornelia, column 20, line 64 to column 21, line 4. In Cornelia, it is only asserted that a user can drag and drop icons to create word processor formatted documents. Nothing in Cornelia teaches, suggests or discloses creating a grammar-neutral object. In Cornelia, it would be incorrect to assert that the icons are equivalent to grammar-neutral document objects because the icons are simply a link to a document or portion of a document. In Applicant's claimed invention, the grammar-neutral document object is created from processing business context rules and assembling document components. Moreover, the grammar-neutral document objects are not readable by a human until further processed, which is distinguishable from Cornelia in that the document that is created is a word processor document that is readable by a human.

Further, it is asserted that Person discloses that document generation rules include context rules as MS Word® discloses templates where a user can click on ASK or FILLIN and enter text. Distinguishable, in Applicant's claimed invention, business contexts are used to create documents that are created with context conditions for a specific business type. Applicant's business context rules are completely different than a fill-in space in a template document, which is already created and static, albeit when a user enters text, which is a manual human process. Additionally, in Applicant's specification, paragraph [0050], a context condition is described. One of ordinary skill in the art would easily be able to distinguish between context conditions, such as "Condition-Geopolitical = IT, Rename ('Address,' Indirizzo')," where IT stands for Italian and the Rename context condition changes the term "address" to its Italian translation. Nothing in MS Word® with respect to templates is equivalent to context conditions, where the business context rules include context conditions for acting on text for a specific business context.

Brauer is simply relied on for converting objects into an XML document. Therefore, even if Cornelia is combined with Person and Brauer, the resulting invention would still not teach, disclose or suggest Applicant's amended claims 1, 8 and 12, as listed above. Further, the assertions made in the Office Action on pages 6-7, 9-12, 14-15 and 17-19 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. And, since neither Cornelia, Person, Brauer, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 8 and 12 as listed below, Applicant's amended claims 1, 8 and 12 are not obvious over Cornelia in view of Person and Brauer since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1 and 8, namely claims 2-7, and 9-12, respectively, would also not be obvious over Cornelia in view of Person and Brauer for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-12 are respectfully requested.

B.   It is asserted in the Office Action that claims 13-15 are rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Cornelia, in view of Person, in further view of Brauer and in further view of *"Stroking the AbiWord Fire"* 2/24/2002 by Hughes ("Hughes"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's claim 13 directly depends on amended claim 12. Applicant has addressed Cornelia in view of Person, and in further view of Brauer regarding amended claim 12 above in section II(A). Applicant's claim 14 directly depends on amended claim 1. Applicant has addressed Cornelia in view of Person, and in further view of Brauer regarding amended claim 1 above in section II(A). Applicant's claim 15 directly depends on amended claim 8. Applicant has addressed Cornelia in view of Person, and in further view of Brauer regarding amended claim 8 above in section II(A).

Hughes is only relied on for disclosing an XML word processor. Even if Cornelia is combined with Person, Brauer and Hughes, the resulting invention would still not teach, disclose or suggest Applicant's the limitations: in amended claim 1 of

> a document generation rule formulator process that a user employs to designate document generation rules through a graphic user interface on a display coupled to the computer system, the document generation rules including assembly rules and business context rules; a document component library for storing and managing document component summary information and document components that represent specific concepts; a component assembler process for processing the assembly rules and assembling said document components from the document component library; a context process for processing the business context rules and creating a grammar neutral document object from the assembled document components, the component assembler process and the context process making up a document generation rule process; and a document grammar connector process for converting the grammar neutral document object, which is suitable for program processing in the computer system, into a grammar-connected document for a specific type of business that is in a human-readable string form for use in an actual business, wherein the business context rules include context conditions for acting on text for a specific business context,

Applicant's amended claim 8 of

> (b)   designating document generation rules through a graphic user interface, the document generation rules to include assembly rules and business context rules; (c) accumulating   document components needed for document assembly from a document component library according to the assembly rules, and generating grammar neutral document objects based on the business context rules; and (d) converting the grammar neutral document objects, which are suitable for processing in a program of a computer system, into grammar-connected documents in a human-readable string form used in a specific actual business, wherein the business context rules include context conditions for acting on text for a specific business context,

nor Applicant's amended claim 12 of

> designating document generation rules through a graphic user interface, the document generation rules to include assembly rules and business context rules; accumulating document components needed for document assembly from a document component library according to the assembly rules, and generating grammar neutral document objects from the accumulated document components based on the business context rules; and converting the grammar neutral document objects, which are suitable for processing in a program of a computer system used in an actual and specific type of business, into grammar-connected documents in a human-readable string form, wherein the business context rules include context conditions for acting on text for a specific business context.

Further, the assertions made in the Office Action on pages 19-20 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. And, since neither Cornelia, Person, Brauer, Hughes, and therefore, nor the combination of the four, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 8 and 12 as listed below, Applicant's amended claims 1, 8 and 12 are not obvious over Cornelia in view of Person, Brauer and further in view of Hughes since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly depend from amended claims 1, 8 and 12, namely claims 15, 14, and 13, respectively, would also not be obvious over Cornelia in view of Person and Brauer and further in view of Hughes for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 13-15 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-15 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: <u>December 18, 2007</u>   By: _____

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CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.

_____
Jean Svoboda   Date: December 18, 2007